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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/981,565

10/17/2001

Andrew C. Gilbert

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EXAMINER

TRAN, HAI

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/981,565	<b>Applicant(s)</b> GILBERT ET AL.	
	<b>Examiner</b> HAI TRAN	<b>Art Unit</b> 3694	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is the communication in response to Applicant's Request for Continued Examination and Remarks filed on March 24, 2008 for its application case 09/981,565, titled: "Systems and Methods for Bid/Offer Spread Trading".
2. Claims 1-27 have been cancelled. Claims 28-40 have been amended.
3. Accordingly, claims 28-40 remain pending in this application and have been examined.

### ***Continued Examination Under 37 CFR 1.114***

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 24, 2008 has been entered.

### ***Priority***

5. This application claims the benefit of U.S. Provisional Patent Application No. 60/280,668, filed March 30, 2001.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3694

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 31 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically,

8. Claims 31 and 36 recite the word “automatically” is indefinite because a person of ordinary skill in the art would be uncertain how it is performed. It is unclear how the automatic function is performed when all the commands in the parent claim require input from the users. Also, paragraph 53 of the specification does not have any detail to describe how the automatic function is performed. The metes and bounds cannot be understood because of the lack of definiteness in the claims.

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 31 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

11. Claims 31 and 36 recite the phrase of “automatically entering a default trading command from the first party or second party” is unclear how the automatic function is

Art Unit: 3694

performed. Applicant's specification, paragraph 53 only mentions that "default trades may be automatically entered" and does not have any detail to describe how the automatic function is performed. The claims contain subject matter which is not described in the specification in such a way as to enable one in the ordinary skill in the art to make and/or use the invention.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 28-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaminsky et al. (U.S. Patent Application Publication No. 2002/0082967) ("Kaminsky").

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

14. **With respect to Claim 28**, Kaminsky teaches a method comprising:

receiving a first command from a first party, in which the first command indicate that a spread market should be made, in which the spread market including a first

spread with which a first market for a financial instrument may be made and includes a second spread with which a second market for the financial instrument may be made, and in which the first command includes an acceptance by the first party to participate in the first market if a second party accepts the first spread and an acceptance by the first party to make the second market if the second party accepts the second spread (see paragraph 83);

transmitting information about the spread market to the second party (see paragraph 83); and

receiving a second command from the second party, in which the second command comprise at least one of an acceptance of the first spread and an acceptance of the second spread (see paragraph 84);

if the second command comprises the acceptance of the first spread, requiring the first party to submit a third command indicating at least one of a buy and a sell of the financial instrument through the first market (see paragraphs 83-85, figures 3 and 4), and

if the second command comprises the acceptance of the second spread, requiring the second party to submit a third command indicating at least one of a buy and a sell of the financial instrument through the second market (see paragraphs 83-85, figures 3 and 4).

15. **With respect to Claims 29 and 37**, Kaminsky teaches that the method of claim 28, in which the second command comprises the acceptance of the first spread and requiring the first party to submit the third command includes blocking the first party

from participating in a market if the third command indicating at least one of a buy and a sell of the financial instrument through the first market is not received from the first party within a limited period of time (see paragraphs 88, 108-114).

16. **With respect to Claims 31 and 36**, Kaminsky teaches that the method of claim 28, in which the second command comprises the acceptance of the first spread and requiring the first party to submit the third command includes automatically entering a default trading command from the first party if the third command indicating at least one of a buy and a sell of the financial instrument item through the first market is not received from the first party within a limited period of time (see paragraphs 116-117).

17. **With respect to Claim 32**, Kaminsky teaches that he method of claim 28, in which the first spread and the second spread are the same (see paragraph 83).

18. **With respect to Claims 33 and 38**, Kaminsky teaches that the method of claim 28, in which the second command comprises the acceptance of the first spread and the method further comprises: requiring the second party to submit a fourth command indicating that the first market for the financial instrument should be made with the first spread (see paragraphs 82-86, figure 3/all elements).

19. **With respect to Claims 34 and 39**, Kaminsky teaches that the method of claim 33, in which the fourth command includes an indication of a price around which the first market should be made (see paragraphs 82-86, figure 3/all elements).

20. **With respect to Claim 40**, this computer readable medium claim is for implementing the method claims 28-39 and has the same steps and limitations. Hence, it is rejected under the rationale in claims 28-39 (see al in Kaminsky reference).

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 30 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminsky in view of Official Notice.

23. **With respect to Claims 30 and 35**, Kaminsky teaches that the method of claim 29, in which the second command comprises the acceptance of the first spread and requiring the first party to submit the third command includes charging a fee to the first party if the third command indicating at least one of a buy and a sell of the financial instrument through the first market is not received from the first party within a limited period of time (see paragraph 88, 108-114 and note below).

24. Kaminsky teaches requiring parties to respond within a period of time, but does not expressly teach charging a fee to the parties if the command is not received within a period of time. The Examiner takes an Official Notice that charging a fee for not responding in a timely manner is old and well known in the art of business. The motivation is to assure the traders to respond in a timely manner and thus improve the liquidity in the security exchange market.



***Conclusion***

25. Claims 28-40 are rejected.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAI TRAN whose telephone number is (571)272-7364.

The examiner can normally be reached on M-F, 9-4 PM.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. T./  
Examiner, Art Unit 3694

/James P Trammell/  
Supervisory Patent Examiner, Art Unit 3694